

REMARKS

In the Action, claims 1-4 and 6 are rejected, and claim 5 is withdrawn from consideration as being directed to the non-elected invention. In response, claims 1 and 6 are amended. Claim 1 is amended to recite the coated paper being smoothed by a calender and where the oil absorbency under pressure is determined by an amount of soybean oil absorbed at a pressure of 50 kPa for 20 seconds. Claim 6 is amended in a similar manner and to be in independent form. These amendments are supported by the specification in paragraphs 0031, 0014 and 0015. Accordingly, these amendments are supported by the specification and do not introduce new matter.

In view of these amendments and the following comments, reconsideration and allowance are requested.

The Rejections

Claims 1, 2 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,376,237 to Ishiguro et al. or U.S. Patent No. 6,572,951 to Hasegawa et al.

The cited patents do not disclose or suggest a coated paper for newsprint inks having a coating layer containing a pigment and an adhesive that is smoothed by a calender and has the combination of a coat weight of 4.0 g/m^2 or more per side, an oral absorbency under pressure of 20 g/m^2 or more, and a Bekk smoothness of 75 seconds or less where the oil absorbency under pressure is determined using soybean oil absorbed at a pressure of 50 kPa for 20 seconds. Accordingly, the claims are not anticipated by or obvious over the cited patents. In particular, the cited patents do not disclose the combination of a coated paper that has been smoothed in a calender where the resulting paper has an oil absorbency under load and Bekk smoothness within the claimed range. The cited patents do not disclose either

expressly or inherently an oil absorbency under pressure of soybean oil at 50 kPa for 20 seconds within the claimed range.

As disclosed in the specification, the pigment coated paper for newsprint inks of the present invention exhibits good ink drying properties, little stickiness, good printability and good reproduction and sharpness. See, for example, paragraphs 0010 to 0013 and 0015 to 0017 of the specification. The invention is directed to finding a good balance between printability such as stickiness and the print quality such as by ink receptivity or print sharpness by providing the combination of a specified coating weight, a controlled oil absorbency under pressure and Bekk smoothness to ensure high color printability when newsprint inks are used. See, for example, paragraph 0013 of the present specification.

Ishiguro et al. does not disclose a coated paper having a Bekk smoothness within the claimed range. Independent claims 1 and 6 as amended recite the coating layer being smoothed by a calender to obtain a coated paper having a Bekk smoothness of 75 seconds or less. The Action refers to Table 1 of Ishiguro et al. Table 1 discloses Examples B1, B2 and B3 before calendering having a smoothness of 45 seconds, 42 seconds and 43 seconds, respectively. Comparative Examples C1, C2 and C3 are after calendering and exhibit a smoothness of 100 seconds, 110 seconds and 120 seconds, respectively. Thus, Ishiguro et al. does not disclose or suggest a coated paper smoothed by calendering and having a Bekk smoothness within the claimed range.

Ishiguro et al. also does not disclose an oil absorbency under pressure within the claimed range. Ishiguro et al. refers only to an average oil absorptiveness of 65 cc/100 grams. The oil absorptiveness of Ishiguro et al. does not correspond to the claimed oil absorbency under pressure. Furthermore, Ishiguro et al. refers to the oil absorptiveness of the pigment composition and not the coated paper that is smoothed by calendering.

Ishiguro et al. further fails to disclose either expressly or inherently an oil absorbency under pressure. The oil absorptiveness of Ishiguro et al. is not based on an amount of soybean oil absorbed by a coated paper under a pressure of 50 kPa in 20 seconds. The oil absorptiveness of Ishiguro et al. is expressed in the volume per weight (100 g). The Action has not shown that these units correspond to the claimed 20 g/m^2 .

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to modify Ishiguro et al. to obtain a coated paper that is smoothed by calendering to obtain an oil absorbency under pressure and having a Bekk smoothness of 75 seconds or less or an oil absorbency of 20 g/m^2 or more as in claims 1 and 6. Ishiguro et al. provides no incentive to modify Ishiguro et al. to provide a Bekk smoothness within the claimed range. Furthermore, as noted above, Ishiguro et al. only discloses a coated paper obtained by calendering as having a Bekk smoothness outside the claimed range. Furthermore, Ishiguro et al. discloses a coated paper having a surface that is smoother than that of the claimed invention. Therefore, the resulting paper of Ishiguro et al. would not have the improved printability of the claimed invention as disclosed in paragraph 0016 of the present specification. Accordingly, independent claims 1 and 6 and the claims depending therefrom are not obvious over Ishiguro et al.

Hasegawa et al. also does not disclose a coated paper that is smoothed by calendering and has an oil absorbency under pressure of 20 g/m^2 or more as determined by the method of claims 1 and 6 and a Bekk smoothness of 75 seconds or less. Hasegawa et al. is specifically directed to a printing sheet for stencil printing such as by mimeograph printing or screen printing. Hasegawa et al. is not directed to a coated paper for newsprint inks as in the present invention.

Hasegawa et al. discloses only two pigment coated papers in Examples 1 and 2. These Examples exhibit an Oken smoothness of 85 seconds and 120 seconds, respectively.

Thus, the pigment coated paper for stencil printing of Hasegawa et al. has a smoothness outside the claimed range. Examples 3 and 4 of Hasegawa et al. are not pigment coated papers as in the claimed invention. Examples 3 and 4 of Hasegawa et al. are coated with an oxidized starch as a water soluble binder without the use of a pigment.

Thus, Hasegawa et al. does not disclose or suggest a coated paper for newsprint inks where the coating layer contains a pigment and an adhesive and is obtained by smoothing by calendering where the coated paper has an oil absorbency under pressure of 20 g/m² or more and a Bekk smoothness of 75 seconds or less. Hasegawa et al. also clearly fails to disclose or suggest an oil absorbency under pressure of 20 g/m² or more where the oil absorbency under pressure is determined by an amount of soybean oil absorbed at a pressure of 50 kPa for 20 seconds as in the claimed invention. Accordingly, independent claims 1 and 6 are not anticipated by or obvious over Hasegawa et al.

Hasegawa et al. provides no suggestion to one of ordinary skill in the art to provide a Bekk smoothness within the claimed range of 75 seconds or less in a pigment coated paper that is smoothed by calendering. Hasegawa et al. provides no reasonable expectation of success that modifying the Bekk smoothness within the claimed range will provide improved newsprint printability. Based on the disclosure of Hasegawa et al., it would not have been obvious to one of ordinary skill in the art to obtain the claimed invention. Hasegawa et al. is specifically directed to printing sheets suitable for stencil printing. There is no suggestion in Hasegawa et al. of a coated paper for newsprint inks. Accordingly, the claimed coated paper for newsprint inks would not have been obvious to one of ordinary skill in the art over Hasegawa et al.


Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being obvious over Ishiguro et al. or Hasegawa et al. in view of U.S. Patent Publication No. 2005/0016701 to Nisogi et al.

or EP 1 001 082 to Tadokoro et al. and EP 1 016 755 to Tadokoro et al. Nisogi et al. and EP '082 are cited for disclosing bulking agents.

For the reasons discussed above, independent claim 1 is not obvious over Ishiguro et al. or Hasegawa et al. The secondary references do not provide the deficiencies of Ishiguro et al. or Hasegawa et al. Nisogi et al. and Tadokoro et al. do not suggest to one skilled in the art a coated paper containing a pigment and an adhesive having a Bekk smoothness within the claimed range. The secondary patents also do not suggest a coated paper having an oil absorbency under pressure within the claimed range. Moreover, the secondary references provide no suggestion to one skilled in the art that the bulking agents can be used in the paper for stencil printing as disclosed in Hasegawa et al. or the paper of Ishiguro et al. while providing a Bekk smoothness and oil absorbency under pressure within the claimed range. Therefore, even if one were to combine the teachings of the secondary references with Ishiguro et al. or Hasegawa et al., the resulting coated paper would not be the claimed invention.

In view of these amendments and the above comments, Applicants respectfully submit that the claims are not anticipated by or obvious over the art of record. Accordingly, reconsideration and allowance are requested.

Respectfully submitted,


Garrett V. Davis
Reg. No. 32,023

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, DC 20036
(202)659-9076

Dated: Sept 30, 2010